REMARKS

Claims 1-43 are pending in the above-referenced patent application. Claims 1-43 were rejected. Specifically, claims 1-10, 12, 15-23, 25-31, 33 and 34 were rejected under 35 USC 102(e) as being unpatentable over Soetemans (US Pub. No. US2003/0058618). Claims 13 and 14 were rejected under 35 USC 103(a) as being unpatentable over Soetemans in view of Trans (USPGPUB no. 2002/0181633). Claims 11, 24, 32, 35-43 were rejected under 35 USC 103(a) as being unpatenable over Soetemans in view of Kim (USPN 6,473,788). Claim 39 has been amended to further clarify the claimed limitations. The amendments are supported by the specification. New matter has not been added.

In the addition to the arguments provided hereinbelow, Applicant reserves the right to provide further arguments/evidence in support of allowability of the claims.

Claim rejections under 35 U.S.C. 102(e)

Rejection of claims 1-10, 12, 15-23, 25-31, 33 and 34 as being anticipated by Soetemans is respectfully traversed because, for at least the following reasons, Soetemans does not disclose all of the claimed limitations. Without admitting that Soetemans constitutes prior art, Applicant provides the following arguments in support of allowance of the claims over Soetemans, and Applicant reserves the right to swear behind Soetemans by filing a declaration Under 37 CFR § 1.131 if desired by Applicant.

As per Claim 1, Soetemans does not disclose a network backplane interface for a local network that has a circuit board with a plurality of sockets connected to the circuit board for receiving plug-in network devices, wherein the backplane includes: "power lines on the circuit board to one or more sockets for powering a plug-in network device in each socket," as required by Claim 1. Soetemans generally mentions circuit boards and sockets, however in paragraph 0023, lines 9-12 (relied on by the Examiner), Soetemans does not disclose power lines on a circuit

board to one or more circuit boards, for powering a plug-in network device in each socket. Rather, in paragraph 0023, lines 9-12, Soetemans mentions power filters 210a-d for powering subshelf positions of subshelf 125, but does not teach a circuit board and power lines on that circuit board for powering subshelf positions of subshelf 125. Power filters 210a-d are not power lines on a circuit board, as claimed.

Further, Soetemans does not disclose: "communication lines on the circuit board to each socket for communication with the plug-in network devices," as required by Claim 1. In paragraph 0025 (relied on by the Examiner), Soetemans mentions subshelves 110a-d provide data path functionality by virtue of cards mounted to the front and back side slots of their respective midplanes. However, this does not teach or require that subshelves 110a-d or cards comprise a circuit board which includes communication lines thereon to each socket, along with the power lines discussed above.

It is respectfully submitted that in rejecting Claim 1, the Examiner has not identified (such as by reference numbers) a circuit board in Soetemans that includes power lines and communications on the circuit board for powering and communicating with devices in sockets, as claimed. General mention of a circuit board, sockets and power filters or communication cards in Soetemans, does not disclose: "power lines on the circuit board to one or more sockets for powering a plug-in network device in each socket," and "communication lines on the circuit board to each socket for communication with the plug-in network device," as required by Claim 1. The Examiner has not met the burden of proof in showing that Soetemans teaches all of the claimed limitations.

Further Soetemans in Figs. 1A, 1B, 3, paragraphs 0003, 0015 (relied on by the Examiner), or elsewhere, does not show or mention any sockets on a circuit board for plugin-devices, wherein each socket received power and communications lines that are on the circuit board, as claimed. Besides a general references to sockets in paragraph 0003, Soetemans does not even mention a

socket as claimed in description of the invention therein. Certainly, Soetemans does not disclose or show a housing with openings that expose sockets on a circuit board for plugin-devices, wherein each socket receives power and communications lines that are on the circuit board. Mention of a socket and a shelf 100 in Soetemans, has nothing to do with "a plurality of sockets connected to the circuit board for receiving plug-in network devices", and "a housing for the circuit board, power lines and communication lines, including openings for exposing said sockets," as required by Claim 1. It is respectfully submitted that in rejecting Claim 1, the Examiner has not identified (such as by reference numbers) a circuit board with a plurality of sockets connected thereto, and a housing including openings for exposing said sockets. The examiner refers to elements 125 with a housing bay in Soetemans, and element 1 which is a cooling fan. It is respectfully submitted that elements 1 and 125 in Soetemans, along with a general references to a socket and a circuit board, relied on by the Examiner, do not disclose all of the claimed limitations. For at least these reasons, and other reasons, it is respectfully submitted that rejection of Claim 1, and claims dependent therefrom, should be withdrawn.

As per claim 2, it is respectfully submitted that elements 120a, 120b in Fig. 3 of Soetemans (relied on by the Examiner), do not disclose: "a communication controller which allows communication between the plug-in devices," as claimed. Rather, elements 120a, 120b in Fig. 3 of Soetemans are shelf-controllers, and the services provided by them to each of the subshelves 110a-d doe not include such limitations. Nowhere in Soetemans is it disclosed that shelf controllers 120a-b are a communication controller which allows communication between the plug-in devices, as claimed. Apart from a general reference to Fig. 3, the Examiner has not pointed to language in Soetemans that teaches that shelf-controllers 120a-b disclose the claimed limitations.

As per claim 3, it is respectfully submitted that Fig. 6, and elements 120a, 120b in Fig. 3 of Soetemans (relied on by the Examiner), do not disclose: "a configuration circuit on the circuit board which allows configuring function of one or more plug-in devices to perform desired functions," as claimed. As discussed in relation to claim 2, elements 120a, 120b in Fig. 3 of

Soetemans are shelf-controllers. The shelf-controllers 120a, 120b are not an configuration circuit that is on a circuit board along with the power lines, communication lines, and sockets, as claimed. The shelf-controllers 120a, 120b provide services which do include configuring function of devices to perform desired functions. There is no such disclosure in Soetemans. In Fig. 6, Soetemans shows a flowchart that mentions determining services provided by functional elements, and grouping the services based on hotel service requirements. There is no teaching or disclosure that shelf-controllers 120a, 120b (or any other devices for that matter), configure operation of the functional elements in the shelves to perform desired functions (e.g., based on hotel service requirements). Apart from a general reference to Figs. 3 and 6, the Examiner has not pointed to language in Soetemans that teaches that Figs. 3, 6 or shelf-controllers 120a-b disclose the claimed limitations.

As per Claim 4, it is respectfully submitted that for at least the reasons provided above in relation to claim 3, Soetemans does not disclose that the configuration circuit communicates with a plug-in device in a socket to identify the plug-in device and configure the plug-in device for network communication function, as required by claim 4.

Rejection of Claim 5 is respectfully traversed for at least the reasons provided in relation to Claim 3. Further, in paragraph 0032 (relied on by the Examiner), Soetemans only mentions a database of profiles for determining status of each subshelf. The profile is for shelf-controllers 120a-b to determine status of devices, not for configuring a device to perform a desired function, as claimed. Soetemans's profiles are not configuration instructions, as claimed. Further, Soetemans does not disclose a "memory for storing configuration instructions for configuring one or more different plug-in devices," as claimed. There is no such memory in Soetemans. The claimed herein memory is in the configuration circuit that is on the circuit board. There is no mention of memory on a circuit board in Soetemans, and the database in Soetemans is not a memory as is not on a circuit board. Memory, or memory on a circuit board is not inherent, nor required, in Soetemans since the database is indeed typically on a disk drive in a shelf. Further,

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the profile in Soetemans is for shelf-controllers 120a-b to determine status of devices, not for configuring a device to perform a desired function. Further, Soetemans does not disclose that shelf-controllers 120a-b are processors, or processors on a circuit board with the power lines and communication lines for each socket, or that shelf-controllers 120a-b execute profiles to configure a device in each socket, as claimed.

As per Claim 6, it is respectfully submitted that for at least the reasons provided above in relation to claim 5, Soetemans does not disclose that a configuration circuit includes a configuration memory having configuration information for a plurality of predetermined plug-in device types, as required by claim 6.

As per Claim 7, it is respectfully submitted that for at least the reasons provided above in relation to claim 5, Soetemans does not disclose that a configuration circuit includes extended configuration memory for storing configuration information for additional device type, as required by claim 7.

As per Claim 8, it is respectfully submitted that for at least the reasons provided above in relation to claims 3 and 5, Soetemans does not disclose that the configuration circuit includes an embedded configuration module to configure plug-in devices in a configuration session, as required by claim 8. There is no mention of configuring a device, or a configuration session anywhere in Soetemans.

As per Claim 9, it is respectfully submitted that for at least the reasons provided above in relation to claims 3, 5 and 8, Soetemans does not disclose that a configuration module configures all plug-in devices in one configuration session, as required by claim 9. Further, there is no mention of a configuration module or configuration session in paragraph 0013 of Soetemans (relied on by the Examiner), or Fig. 6.

As per Claim 10, it is respectfully submitted that for at least the reasons provided above in relation to claims 3, 5, 8 and 9, Soetemans does not disclose that the configuration module comprises a platform-independent configuration software, as required by claim 10. Indeed, in paragraph 0006, lines 13-22 (relied on by the Examiner), Soetemans states: "In one embodiment, the common support services that are provided include power supply services, environmental control services, information display services, and operational control and management services. In one embodiment, the subshelf bay is provided with standardized means used to supply the common support services to the subshelves. In one embodiment, each sub-shelf contains its own midplane and is operationally independent from other subshelves. The use of subshelves and the separation of providing support services (provided by the infrastructure) from providing data path functionality (provided by the subshelves) allows data path functionality to be enhanced by replacement of a subshelf without requiring redesign of the entire shelf unit."

Applicant is at a loss as to where in the above-quoted passage Soetemans discloses a configuration module that comprises a platform-independent configuration software. Applicant respectfully requests that the Examiner clarify this point if claim 10 is rejected again.

As per claim 12, it is respectfully submitted that Soetemans does not disclose "at least one socket is dedicated to connection and communication with an external network," as required by Claim 12. Soetemans, paragraph 0033, line 7 (relied on by the Examiner), only mentions Ethernet connection, but mentions nothing about a socket for connection to an external network, as claimed. Further, Soetemans does not disclose a socket on a circuit board that is *dedicated* to connection and communication with an external network, as claimed.

As per claim 15, it is respectfully submitted that Soetemans does not disclose a socket comprising a RJ-45 socket on a circuit board, as claimed. Paragraph 0033, line 7 (relied on by the Examiner), only mentions Ethernet connection, not a RJ-45 socket on a circuit board, along with power lines and communication lines on the circuit board, as claimed.

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As per claim 16 it is respectfully submitted that Soetemans does not disclose that a socket on a circuit board, comprises a proprietary connector combining power and data connections, along with power lines and communication lines on the circuit board.

As per claim 17, it is respectfully submitted that Soetemans does not disclose a plurality of sockets wherein each socket receives power and communications lines, as claimed. Besides a general references to sockets in paragraph 0003, Soetemans does not even mention a socket as claimed in description of the invention therein. It is respectfully submitted that in rejecting Claim 17, the Examiner has not identified in Soetemans (such as by reference numbers) a plurality of sockets with power and communication lines connected to each socket for powering and communicating with a plug-in device in each socket, as claimed.

Further, Soetemans does not disclose: "a configuration module for functional configuration of one or more plug-in devices, wherein the configuration module communicates with each plug-in device in each socket to identify the plug-in device and configure function of the plug-in device to perform desired functions," as required by claim 17. The Examiner has made general references to paragraphs 0006, 0026 and 0037 of Soetemans, without specifying how the claimed limitations are disclosed. In rejecting Claim 17, the Examiner has not identified in Soetemans (such as by reference numbers) such a configuration manager and its functions, as claimed. In paragraph 0006 (relied on by the Examiner) Soetemans provides a general description of the shelf 100 and subshelves, but mentions nothing about a configuration module that communicates with each plug-in device in each socket to identify and then configure function of the plug-in device to perform desired functions, as claimed. In paragraph 0026 (relied on by the Examiner) Soetemans mentions the subshelves in Figs. 2A-B, and the types of cards that can be installed in the subshelves, but mentions nothing about a configuration module that communicates with each plug-in device in each socket to identify and then configure function of the plug-in device to perform desired functions, as claimed. In paragraph 0037 (relied on by the Examiner), Soetemans

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discussed that Fig. 6 shows a flowchart that mentions determining services provided by functional elements, and grouping the services based on hotel service requirements. There is no teaching or disclosure that shelf-controllers 120a, 120b (or any other devices for that matter), configure operation of the functional elements in the shelves to perform desired functions (e.g., based on hotel service requirements). As discussed above at least in relation to claim 3, Soetemans does not teach configuring devices in sockets to perform desired functions. For at least these reasons, it is respectfully submitted that rejection of Claim 17, and all claims dependent therefrom, should be withdrawn.

As per claim 18, it is respectfully submitted that Soetemans does not disclose a configuration module that comprises memory for storing configuration instructions for configuring one or more different plug-in devices, and processor for executing the configuration instructions to communicate with a plug-in device in a socket, and configure that device for network communication, as required by Claim 18. Sub-shelves controller 120a in Soetemans is not memory as claimed, and does not store configuration instructions for configuring one or more different plug-in devices, as claimed. Sub-shelves controller 120a in Soetemans is not a processor as claimed, and does not execute any configuration instructions to communicate with a plug-in device in a socket, and configure that device for network communication, as claimed. The Examiner's interpretation of Soetemans is respectfully traversed.

As discussed above in relation to claim 5, Soetemans only mentions a database of profiles for determining status of each subshelf. The profile is for shelf-controllers 120a-b to determine status of devices, not for configuring a device to perform a desired function, as claimed. Soetemans's profiles are not configuration instructions, as claimed. The profile in Soetemans is for shelf-controllers 120a-b to determine status of devices, not for configuring a device to perform a desired function. The Examiner's interpretation of Soetemans is respectfully traversed.

As per claim 19, it is respectfully submitted that for at least the reasons provided above in

relation to claims 17 and 18, Soetemans does not disclose that a configuration module includes a configuration memory having configuration information for a plurality of predetermined plug-in device types, as required by claim 19. Further, Sub-shelves controller 120a is not, and does not include, memory with configuration, as claimed. There is no mention of memory having configuration information in paragraph 0039, lines 1-2 of Soetemans, relied on by the Examiner. The Examiner's interpretation of Soetemans is respectfully traversed.

As per claim 20, it is respectfully submitted that for at least the reasons provided above in relation to claims 17 and 18, Soetemans does not disclose that the configuration module includes extended configuration memory for storing configuration information for additional device types, as required by claim 20. Further, Sub-shelves controller 120b is not, and does not include, extended memory with additional configuration information, as claimed. The Examiner's interpretation of Soetemans is respectfully traversed.

As per claim 21, it is respectfully submitted that for at least the reasons provided above in relation to claims 5, 9, 11, 17, 18, 19 and 20, Soetemans does not disclose a configuration module that allows configuring plug-in devices in a configuration session for network communication among the plug-in devices, as required by Claim 21. The Examiner's interpretation of Soetemans is respectfully traversed.

As per claim 22, it is respectfully submitted that for at least the reasons provided above in relation to claims 5, 9, 11, 17, 18, 19 and 20, Soetemans does not disclose that the configuration module configures all plug-in devices in one configuration session, as required by Claim 22. The Examiner's interpretation of Soetemans is respectfully traversed.

As per claim 23, it is respectfully submitted that for at least the reasons provided above in relation to claims 5, 9, 11, 17, 18, 19 and 20, Soetemans does not disclose the configuration module comprises a platform-independent configuration software, as required by Claim 22. In addition as discussed further above, Fig. 6 in Soetemans shows a flowchart that mentions

determining services provided by functional elements, and grouping the services based on hotel service requirements. There is no teaching or disclosure in Fig. 6 of a platform-independent configuration software that allows configuring plug-in devices in a configuration session for network communication among the plug-in devices, as claimed. The Examiner's interpretation of Soetemans is respectfully traversed.

As per claim 25, it is respectfully submitted that Soetemans does not disclose a plurality of sockets wherein each socket receives power and communications lines, as claimed. Besides a general references to sockets in paragraph 0003, Soetemans does not even mention socket in description of the invention therein. It is respectfully submitted that in rejecting Claim 25, the Examiner has not identified in Soetemans (such as by reference numbers) a plurality of sockets with power and communication lines connected to each socket for powering and communicating with a plug-in device in each socket, as claimed. Further, it is respectfully submitted that elements 120a, 120b (relied on by the Examiner) are shelf-controllers and do not teach a switch connected to each socket allowing communication with the plug-in network devices, as claimed. The Examiner's interpretation of Soetemans is respectfully traversed.

In addition, it is respectfully submitted that for at least the reasons provided in relation to claim 17, Soetemans does not disclose: "a configuration module for functional configuration of one or more plug-in devices, wherein the configuration module communicates with each plug-in device in each socket to identify the plug-in device and configure the plug-in device to perform selected functions," as required by claim 25. Further, the Examiner has made general references to fig. 6, and paragraphs 0026 and 0037 of Soetemans, without specifying how the claimed limitations are disclosed. In rejecting Claim 25, the Examiner has not identified in Soetemans (such as by reference numbers) such a configuration manager. In paragraph 0026 (relied on by the Examiner) Soetemans mentions the subshelves in Figs. 2A-B, and the types of cards that can be installed in the subshelves, but mentions nothing about a configuration module that communicates with each plug-in device in each socket to identify and then configure function of the plug-in

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device to perform selected functions, as claimed. In paragraph 0037 (relied on by the Examiner), Soetemans mentions that Fig. 6 shows a flowchart that mentions determining services provided by functional elements, and grouping the services based on hotel service requirements. There is no teaching or disclosure that shelf-controllers 120a, 120b (or any other devices for that matter), configure operation of the functional elements in the shelves to perform selected functions, as claimed. As discussed in above at least in relation to claim 3, Soetemans does not teach configuring devices in sockets to perform desired functions. The Examiner's interpretation of Soetemans is respectfully traversed. For at least these reasons, it is respectfully submitted that rejection of Claim 25, and all claims dependent therefrom, should be withdrawn.

Claims 26-31 and 33 were rejected for the same reasons as rejection of claims 18-23, and should therefore be allowed for at least the reasons provided above in relation to claims 18-23.

As per claim 34, it is respectfully submitted that for at least the reasons provided in relation to claims 1, 3 and 5, Soetemans paragraph 0003, line 5, (relied on by the Examiner), or elsewhere, does not disclose an interface module comprising a backplane for the sockets, power lines, switch and configuration module, wherein the backplane comprises a printed circuit board, as claimed. Further, Soetemans does not even mention a printed circuit board. The Examiner's interpretation of Soetemans is respectfully traversed.

Claim rejections under 35 U.S.C. 103(a)

Rejection of claims 13 and 14 under 35 USC 103(a) as being unpatenable over Soetemans in view of Trans is respectfully traversed because for at least the reasons provided herein, the references, alone or in combination, do not disclose all of the claimed limitations.

As discussed above, Soetemans does not disclose all of the limitations of base claim 1. Further, as discussed above in relation to claim 12 (from which claims 13 and 14 depend),

Soetemans does not disclose at least one socket is dedicated to connection and communication with an external network.

Further, as per claim 13, as the Examiner also recognizes, Soetemans does not disclose a switch for connecting a security module between a socket for external connection, and the local network. Further, as per claim 14, Soetemans does not disclose a connection for bridging a security module between said socket for external connection, and the local network.

However, the Examiner states that such limitations are known in the prior art. Applicant respectfully traverses such statement and conclusion by the Examiner. The Examiner has not provided a qualifying references that discloses: a switch for connecting a security module between said socket for external connection, and the local network (Claim 13); or, backplane with a connection for bridging a security module between a socket for external connection, and the local network (Claim 14). It is respectfully submitted that Trans, is directed to means and method for a synchronous network communications system, and is non-analogues art. Trans has nothing to do with the present invention. It is respectfully submitted that Trans does not disclose the claimed limitations in Claims 13-14. As per Claim 13, Trans Para. [0100], lines 17-18, relied on by the Examiner, mentions that controls enabled by the Clock transfer system also provide mechanisms for the unique security feature of a personalized electronic signature for each system node (Electronic Deterrence of Network Address (E-DNA)). However, this has nothing to do with a switch for connecting a security module between a socket for external connection, and the local network, as required by Claim 13. A unique security feature of a personalized electronic signature in Trans, is simply not a switch, or a switch for connecting a security module between a socket for external connection, and the local network, as claimed. If the claims are once again rejected, Applicant respectfully requests that the Examiner show the relationship between such disclosure in Trans and the claimed limitations. As per Claim 14, Trans does not disclose a connection for bridging a security module between a socket for external connection, and the local network, as claimed. Trans Para. [0100], lines 17-18, relied on by the Examiner, mentions unique security

feature of a personalized electronic signature, but does not even mention a connection for bridging a security module between a socket for external connection, and the local network, as claimed. If the claims are once again rejected, Applicant respectfully requests that the Examiner show the relationship between such disclosure in Trans and the claimed limitations.

It is well settled that in order for a modification or combination of the prior art to be valid, the prior art itself must suggest the modification or combination, "...invention cannot be found obvious unless there was some **explicit** teaching or suggestion in the art to motivate one of ordinary skill to combine elements so as to create the same invention." *Winner International Royalty Corp. v. Wang*, No. 96-2107, 48 USPQ.2d 1139, 1140 (D.C.D.C. 1998) (emphasis added). "The prior art **must provide** one of ordinary skill in the art the **motivation** to make the proposed molecular modifications needed to arrive at the claimed compound." *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941, 1944 (Fed. Cir. 1992) (emphasis added). No motivation or suggestion is provided in the references to combine them as the Examiner does.

Trans is directed to method for increasing bandwidth while enabling improved security for network communications. Trans provides a clock transfer system, a channel measurement and calibration system, an equalization system, a precision sampling system and a security system. This has nothing to do with the problems solved by the present invention as described above. Soetemans is directed to providing a common support services infrastructure for a network element. There is no suggestion or motivation in Soetemans of switches on a backplane for connecting a security module between a socket for external connection (which Soetemans does not even teach), and the local network. Even if the combination is legally justified (which Applicant traverses), the result does not disclose the claimed limitations. The Examiner attempts to modify Soetemans by Trans, not based on disclosure or suggestion in the references, but based on Examiner's lacking interpretation of the references in the nature and extent of the disclosures therein. It is respectfully submitted that the Examiner is improperly using "hindsight" and the teachings of Applicant's own claimed invention. The Examiner improperly attempts to modify

Soetemans in an attempt to achieve Applicant's claimed invention. For at least these reasons, rejection of Claims 13 and 14 should be withdrawn.

Rejection of dependent claims 11, 24, 32, 35-43 under 35 USC 103(a) as being unpatenable over Soetemans in view of Kim is respectfully traversed because for at least the reasons provided herein, the references, alone or in combination, do not disclose all of the claimed limitations. First, as discussed above, Soetemans does not disclose limitations of base claims 1, 17 and 25.

Further, as the Examiner also recognizes, Soetemans does not disclose the limitations of claims 11, 24, 32, 35-39, 41, 42. However, in an omnibus rejection (which is respectfully noted as being improper), the Examiner states that Kim teaches such claimed limitations. Applicant respectfully disagrees. Kim is non-analogous art dealing with remotely servicing peripherals such printers, and has nothing to do with a network backplane interface for a local network, as claimed.

The Examiner's interpretation of Kim is respectfully traversed. Kim does not disclose the features that the Examiner interprets Kim to disclose. Kim is directed to a method by which certain servicing and maintenance of a network peripheral device can be performed remotely, such as from a centralized service organization of a device manufacturer, over a network, such as the World Wide Web (col. 1, lines 42-47). Fig. 10 relied on by the Examiner shows an HTML page 150 downloaded from a peripheral device to a centralized service station.

As such in Kim, each peripheral provides a user interface HTML page for that peripheral device, whereas as claimed herein, the configuration circuit (not each devices in a socket), provides a user interface for receiving user configuration commands to configure function of one or more plug-in devices to perform a desired function (claims 11, 24, 32, 35-39).

Step S1304 in Fig. 13 (relied on by the Examiner) mentions downloading HTML pages or information from a peripheral device to a centralized service station such as technical support organization. Steps S1424 and S1424 in Fig. 14 (relied on by the Examiner) mention a user selecting a support icon on the page 151, and the centralized service station sending an IP packet to a Technical Support server 1 requesting the server's home page 170. These have nothing to do with the claimed limitations.

As claimed, the configuration circuit in the backplane and handles configuring the devices in the sockets by providing a *common* user interface such via a web browser (claims 38, 39). By contrast in Kim, each peripheral provides its own HTML user interface page to the service station, and as such, there is no requirement or need for a common user interface in Kim.

As per claims 41 and 42 neither Kim, nor Soetemans (or their combination) mention anything remotely similar to the limitations that: "if a plug-in device is not recognized by the configuration circuit, then the configuration circuit obtains configuration instructions for the unrecognized device from a source external to the configuration circuit" (claim 41); or "if a plug-in device is not recognized by the configuration circuit, then the configuration circuit obtains configuration instructions for the unrecognized device from a user" (claim 42). The Examiner has not shown where such limitations are disclosed by the references alone, or in combination.

In addition, as discussed further above herein, Soetemans does not teach a configuration circuit/module for configuring devices in sockets to perform a desired function. As such, simply adding a user interface to Soetemans per Kim (as the Examiner suggests) to receive user commends, still does not disclose the claimed limitations since a user interface for receiving user comments, without a configuration circuit/module in the backplane for configuring devices in sockets to perform a desired function, does not achieve the claimed limitations. In other words, the module that performs the actual configuration of the devices to performs desired functions, is missing from both Soetemans and Kim. As such, a combination of Soetemans and Kim also

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misses such a module that performs the actual configuration of the devices to performs desired functions, as claimed.

It is well settled that in order for a modification or combination of the prior art to be valid, the prior art itself must suggest the modification or combination, "...invention cannot be found obvious unless there was some **explicit** teaching or suggestion in the art to motivate one of ordinary skill to combine elements so as to create the same invention." *Winner International Royalty Corp. v. Wang*, No. 96-2107, 48 USPQ.2d 1139, 1140 (D.C.D.C. 1998) (emphasis added). "The prior art **must provide** one of ordinary skill in the art the **motivation** to make the proposed molecular modifications needed to arrive at the claimed compound." *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941, 1944 (Fed. Cir. 1992) (emphasis added). No motivation or suggestion is provided in the references to combine them as the Examiner does.

As discussed Soetemans does not even teach a configuration circuit/module for configuring devices in sockets to perform a desired function. As such one of ordinary skill in the art would not be motivated to add a user interface per Kim to Soetemans to receive user commands since Soetemans has no capability to configure devices in sockets to perform desired functions. Therefore, such user commands would be useless in a combination of Soetemans and Kim.

Regarding claim 40, for at least the reasons provided in relation claims 3, 5, and 8, it is respectfully submitted that Soetemans does not disclose a configuration circuit that: "further includes embedded configuration instructions for configuring one or more different plug-in devices, such that the configuration circuit uses identity of each plug-in device to obtain corresponding configuration instructions for configuring the different plug-in devices," as claimed. Further, as discussed further herein relation to Fig. 6 of Soetemans, Soetemans shows a flowchart that mentions determining services provided by functional elements, and grouping the services based on hotel service requirements. This has nothing to do with the claimed limitations.

Regarding claim 43, it is respectfully submitted that Soetemans does not disclose that: "if a plug-in device is not recognized by the configuration circuit, then the configuration circuit obtains configuration instructions for the unrecognized device from the unrecognized device itself," as claimed. Soetemans in general, and Fig. 6 in particular (relied on by the Examiner), mentions no such features. As discussed, Soetemans does not teach a configuration circuit/module, and certainly the subshelves in Soetemans do not provide configuration instructions. Soetemans does not even check to determine identity of subshelves.

CONCLUSION

For the foregoing, and other, reasons Applicants believe that the rejected claims should be allowed. Reconsideration and allowance of the rejected claims are respectfully requested.

Please continue to direct all communications regarding the above-referenced patent application to the principal agent of record.

Respectfully Submitted,

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